

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

53588-0510

Pursuant to 37 CFR 1.8(a)(1)(ii) I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office via the electronic filing system in accordance with 37 CFR §§1.6(1)(4) and 1.8(a)(1)(i)(C) on the date indicated below and before 9:00 PM PST.

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name _____

Application Number

09/914,287

Filed

August 23, 2001

First Named Inventor

William L. Honnef

Art Unit

3688

Examiner

Khanh H. Le

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.Registration number 56,543☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Signature

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Telephone number

January 16, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Confirmation Number: 4132
	:	
	:	Group Art Unit: 3688
William L. Honnef, et al.	:	
	:	Examiner: Khanh H. Le
Serial No.: 09/914,287	:	
	:	
Filed: August 23, 2001	:	
	:	
For: STORED VALUE ELECTRONIC	:	
CERTIFICATE PROCESSING	:	

ATTACHMENT FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following clear errors occur in the currently maintained rejections of the Final Office Action mailed October 20, 2008.

A. CLAIM 1

1. The Claims Recite Transferring Value to a Merchant, But Phillips Describes Transferring Value to an Issuer

The Examiner has committed clear factual errors with regard to the rejection of Claim 1 under 35 U.S.C. § 102 (e) as allegedly being anticipated by Phillips et al., U.S. Patent No. 6,615,189 (hereinafter *Phillips*). Specifically, the cited art clearly fails to provide factual support for the Final Office Action.

Claim 1 recites:

receiving and storing certificate information that identifies a recipient of the certificate, a recipient address, and an amount of the electronic stored value certificate;
issuing the electronic stored value certificate from a certificate issuer in response to successfully carrying out a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account associated with a merchant; and
creating and storing a unique identification value for the electronic stored value certificate in association with the certificate information as part of issuing the

electronic stored value certificate;
storing an initial face value of the electronic stored value certificate,
determining a new face value by reducing the initial face value of the electronic
stored value certificate by a portion of the initial face value in response to
receiving information indicating redemption at the merchant of the portion
of the initial face value for goods or services, and
storing the new face value of the electronic stored value certificate;
displaying the new face value of the electronic stored value certificate to the recipient;
repeating the steps of determining, storing, and displaying the new face value in response
to successively received redemption information until the new face value of the
electronic stored value certificate is zero;
wherein the unique identification value is a random value that is non-negotiable in a
commercial credit card network;
wherein the unique identification value is operable for redemption of the electronic stored
value certificate at the merchant by communication of the merchant with the
certificate issuer in a redemption transaction that does not traverse the commercial
credit card network.
(Emphasis added)

The Office Action argues that *Phillips* at abstract, col. 3 line 41-col.4 line 45, FIG. 1 and associated text discloses all the above boldfaced features of Claim 1. These contentions are not supported by the cited references under only reasonable interpretation.

Claim 1 recites a certificate issuer and a merchant. The certificate issuer issues an electronic stored value certificate “in response to successfully carrying out a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account associated with [the] merchant.” The merchant, as featured, is an entity at which a portion of an initial face value of the electronic stored value certificate is redeemed for goods and services.

The cited excerpts of *Phillips* describe that a purchase card may be issued after a purchaser pays an issuer with a check, cash, or other financial methods (col. 3 lines 25-35 and lines 48-50). *Phillips* at best describes issuing an electronic stored value certificate in a purchase transaction that transfers value from the purchaser to the issuer. Specifically, *Phillips* has no description of issuing an electronic stored value certificate “in response to successfully carrying out a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account associated with a merchant”, at which a portion of an initial face value of the electronic stored value certificate is **redeemed for goods and services**.

At page 11 lines 7-18, the Office Action argues that

“if the purchase is used at the merchant the merchant’s account is credited with value which is transferred from the account of a purchaser of the purchase card. Applicant agrees ‘*Phillips describes a method in which an offeror such as credit card issuer may issue a purchase card to a customer.... Specifically, Phillips at col. 3 lines 39-47 discloses that a transaction may be posted to a purchaser’s credit card. In the same passage, Phillips states that, in another embodiment, a purchaser may use check, cash, or other financial methods to obtain a purchase card.*’ Thus Phillips discloses exactly that if the purchase card is used at the merchant the merchant’s account is credited with value which is transferred from the account of a purchaser of the purchase card.”

As can be seen in the above excerpt, the Office Action appears confused about when and from where to where the value is transferred in Claim 1 and in *Phillips*. In Claim 1, the electronic stored value card is issued in response to transferring the value from the purchaser to the merchant. In *Phillips*, the portions (col. 3 lines 39-47 and the same passage) cited by the Examiner does not recite that the value is transferred from the purchaser to the merchant. Rather, *Phillips* describes that when a purchase card is purchased, the value is transferred from a purchaser to the issuer, where the value transfer may use check, cash, or other financial methods or may take credit. In *Phillips*, the merchant gets a value from the issuer and that value has been pre-purchased by a purchaser (i.e., that value has been transferred from the purchaser to the issuer).

The Office Action ignores the recited features of Claim 1 and fails to adduce any evidence in the record to support its arguments that *Phillips* discloses the issuing step of Claim 1 that involves transferring value from a purchaser to a merchant, not to an issuer. This is clear error.

2. Phillips Has No Disclosure of “Displaying the New Face Value” As Claimed

The Office Action contends that Phillips at col. 4 lines 46-57; col. 5 lines 1-5; col. 2 lines 57-59 and 65-67 discloses “displaying the new face value of the electronic stored value certificate to the recipient”, as featured in Claim 1. *Phillips* at col. 4 lines 52-56 states “The purchase card will continue to operate as long as positive balance remains on the card. Some embodiments of the purchase card may have the capacity to have additional purchase value added to them after they have been activated.” The Examiner contends that this excerpt of *Phillips* suggests “displaying the new face value of the electronic stored value certificate to the recipient” in Claim 1.

However, there is no express or inherent disclosure in *Phillips* that a new face value,

which is determined after redemption at a merchant, of the electronic stored value certificate is displayed to the recipient. Indeed, the purchase card of *Phillips* is very much like a conventional credit card. Its activation is done by “mail, fax, otherwise transmit a written acceptance, telephone an acceptance, or electronically transmit, for example, via Web Site, an acceptance by computer or other suitable device” (see *Phillips* at col. 3 lines 8-12). Contrary to the Examiner’s contention, *Phillips* at the recited passage or elsewhere neither explicitly nor inherently discloses “displaying the new face value of the electronic stored value certificate to the recipient”, as featured in Claim 1.

The Office Action ignores the recited features of Claim 1 and fails to adduce any evidence in the record to support its arguments that *Phillips* discloses the displaying step of Claim 1 that involves displaying a new value to the recipient. This is also clear error.

For at least the reasons given above, Claim 1 recites one or more limitations that are not anticipated by *Phillips*. Reversal or removal of the rejection is respectfully requested.

B. OTHER CLAIMS

Independent Claims 23, 24 and 27 are patentable for similar reasons discussed above as to Claim 1. Reversal or removal of the rejection to Claims 23, 24 and 27 is respectfully requested.

Dependent Claims 2-13, 15-19 and 31 depend on and incorporate all the features of one of the independent claims discussed above and are at least patentable for similar reasons discussed above.

C. CONCLUSION

The final Office Action appears to be based upon clear error. Reversal or removal of the rejections is respectfully requested.

Respectfully submitted,

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